REMARKS

In response to the Office Action of June 27, 2006, claim 11 is hereby amended. Claims 11 and 12 were rejected under 35 U.S.C. § 102(b) and under the judicially created doctrine of obviousness-type double patenting. Each of these rejections is addressed below.

Obviousness-type Double Patenting Rejections

The Examiner has maintained the rejection of claims 11 and 12 under the judicially created doctrine of obviousness-type double patenting. As previously noted, Applicant agrees to submit a terminal disclaimer when allowable subject matter is determined.

Rejection under 35 U.S.C. § 102(b)

The Examiner has rejected claims 11 and 12 under 35 U.S.C. § 102(b) as being anticipated by Ogata *et al.* (Nov. 1977) *Proc. Natl. Acad. Sci. USA* 74:4973-4976 and Tanner *et al.* (1998) Biochemistry 27:8852-8861. The Examiner reasons Ortega *et al.* disclose a fragment of the lac operator containing bromouracil residues, which forms a crosslink to the lac repressor upon UV radiation. The Examiner reasons that Tanner *et al.* disclose a synthetic pre-tRNA^{Phe} containing 5-bromouridine and 4-thiouridine residues, which forms a crosslink to the yeast tRNA ligase after UV radiation. From this the Examiner concludes that both Ogata *et al.* and Tanner *et al.* anticipate claims 11 and 12.

The Court of Appeals for the Federal Circuit has stated that anticipation requires the presence in a single prior art reference of each and every element of the claimed invention. Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1458 (Fed. Cir. 1984); Alco Standard Corp. v. Tennessee Valley Auth., 1 USPQ2d 1337, 1341 (Fed. Cir. 1986). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." Scripps Clinic v. Genentech Inc., 18 USPQ2d 1001, 1010 (Fed. Cir. 1991, citations omitted). "To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention either expressly or inherently." Atlas Powder Co. v. Ireco Inc., 190 F.3d. 1342, 1346 (Fed. Cir. (1999) (quoting In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). As explained in detail below, Applicant believes that claims 11 and 12, as amended, are not anticipated by the prior art relied upon by the Examiner.

Independent claim 11, as amended, is drawn to a nucleic acid ligand comprised of one or more photoreactive groups that crosslink a target molecule and includes the limitations that when the target molecule is a protein it is not a nucleic acid binding protein and said nucleic acid ligand is not a nucleic acid having the known physiological function of binding the protein. Support for the amendment to this claim can be found in the Specification which provides that "[t]he SELEX Patent Applications also describe ligand solutions obtained to a number of target species, including both protein targets wherein the protein is and is not a nucleic acid binding protein." (page 23, lines 27-29). Thus, in the case where the target molecule is a protein, it is not a nucleic acid binding protein --i.e., it is not a protein that is known to naturally bind specific nucleic acid sequences.

Ogata *et al.* and Tanner *et al.* describe binding and photocrosslinking between nucleic acid binding proteins --*lac* repressor and tRNA ligase, respectively-- and the specific nucleic acid sequences to which they are known to naturally bind. Thus, this is binding between a nucleic acid binding protein, i.e. a protein whose physiological function involves binding to a specific nucleic acid sequence and the specific nucleic acid sequence recognized by that protein. The authors know that this interaction is there and are using the photocrosslinking technique to explore the binding site. These references each teach an academic research technique for probing known protein-DNA interactions, the end result of which is data about which nucleotides photocrosslink to which amino acids. This data in turn can be used to develop structural models for the protein-DNA interaction of interest. Claim 11, as amended, excludes the target from being such a nucleic acid binding protein and is therefore novel over the cited prior art. Reconsideration and withdrawal of the rejection is respectfully requested.

Applicant believes that the pending claims are in condition for allowance. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefore to deposit account No. 19-5117 if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to be charged to deposit account No. 19-5117.

Respectfully submitted,

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